



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/171,399	10/16/98	SANO	M KINOSHITACAS

IM22/1204
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EXAMINER

EINSMANN, M

ART UNIT	PAPER NUMBER
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1751

DATE MAILED:

13
12/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/171,399

Applicant(s)
Sano et al.

Examiner
Margaret Einsmann

Group Art Unit
1751



☒ Responsive to communication(s) filed on Oct 19, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 10-13 and 15-20 is/are pending in the application.

Of the above, claim(s) 10, 11, and 16-18 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 12, 13, 15, 19, and 20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on 10/19/2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/171,399 is acceptable and a CPA has been established. An action on the CPA follows.

Specification

2. A substitute specification is required pursuant to 37 CFR 1.125(a) because the section of amendment filed on May 9, 2000 in which many grammatical and/or spelling errors were corrected was not entered by this office because it was so extensive as to be burdensome to the clerical staff. The amendments to the claims which were part of that amendment were, however, entered and acted upon in the final rejection of July 21, 2000

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

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Claims 10-13, 15-20 are pending. Claims 10, 11, 16-18 are withdrawn from consideration as being drawn to a nonelected invention. Claims 12, 13, 15, 19 and 20 are being examined in this action. This application contains claims 10,11,16-18 drawn to an invention nonelected. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01. Therefore, applicant did not file a complete response to the final rejection. However, in the interest of compact prosecution, the examiner is acting on the elected claims. The non-elected claims *must* be canceled in response to this action.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 12 and 15 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 6, 7 of copending Application No. 09/189,958. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

This rejection is maintained since applicant has not addressed this issue in the amendment
file 10/19/2000

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Claim Rejections - 35 USC § 102

5. Claims 12-13, 15 and 20 are rejected under 35 U.S.C. 102(b) and (e) as being anticipated by Yamada et al., US 5,622,531. This rejection is maintained as applied in the office action of November 3, 1999 for the reasons of record. The rejection is applied to newly amended claim 12 and newly added claim 20 because the composition of the wool protein used in the examples comprises residual hydrogen peroxide (col 6 lines 55-59) which is listed as one of the polymerization initiators in claim 20.

6. Claims 12, 13, 15, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kimura et. al., US 5,385,836.

A coating for non-woven fabric comprising silk fibroin, gelatin and insolubilized chitosan is disclosed. Noting comparative example 2 in column 7, a composition comprising an epoxy type crosslinking agent (which is certainly a reactive modifier), aqueous fibroin solution, and gelatin is disclosed. Gelatin is an albumin (protein) having a molecular weight of less than 2000. Though there is no molecular weight given for the aqueous solution of fibroin, it is an aqueous solution and thus is in a water soluble form, having been hydrolyzed to a polypeptide, thus

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reducing its molecular weight. Additionally, note example 1 in column 6. A rayon textile substrate is crosslinked with an epoxy compound. Then a coating solution comprising chitosan and a reactive modifier, lactic acid is mixed with gelatin and fibroin. After drying, the coating was treated with another reactive modifier, sodium hydroxide. That example was modified in the next few examples. In example 3 bone powder replaces the gelatin; in example 4 collagen replaces the gelatin. Note example 5 wherein the gelatin was replaced by calcium carbonate, which reads on applicant's metal salt polymerization initiator.

7. Claims 12, 15, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Otoi et al., JP 4-100976 (English translation).

Application example 1 beginning on the bottom of page 15 anticipates these claims as disclosing a coating composition comprising silk fibroin of molecular weight 15,000 reacted with a cationic modifier, (3-chloro-2-hydroxypropyl)trimethylammonium chloride. This rejection is applied to amended claim 12 and newly added claim 20 because the method of producing the silk fibroin results in residual salts ^{in the solution} (page 10 last paragraph). These salts are copper, magnesium or calcium salts. (page 9 first full paragraph).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is (703) 308-3826. The examiner can normally be reached on Monday to Thursday and alternate Fridays from 7:00 A.M. to 4:30 P.M. The fax phone number for this Technology Center is (703) 305-3599

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Margaret Einsmann

MARGARET EINSMANN

PRIMARY EXAMINER 1751

December 1, 2000